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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78514746
Applicant	HONDA MOTOR CO., LTD.
Applied for Mark	RL
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Submission	Appeal Brief
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BRIEF OF APPLICANT

Statement of Facts

This is an appeal of the refusal to register Honda's mark RL for "Automobiles and structural parts thereof" (Application Serial No. 78/514,746) because DaimlerChrysler AG owns a registration of RL-CLASS for "Automobiles and their structural parts" (Registration No. 2,912,328 granted December 21, 2004).

In its application, Honda claimed ownership of Registration No. 2,281,336 of the trademark 3.5RL for "Automobiles and structural parts thereof." That registration is still subsisting and, accordingly, is prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on . . . the goods . . . specified in the certificate [of registration]." Lanham Act section 7(b), 15 U.S.C. § 1057(b). The priority date of Honda's rights under this registration is its filing date, July 17, 1998. Lanham Act section 7(c), 15 U.S.C. § 1057(c). The numerical portion of the mark, 3.5 is instantly recognizable to any automobile aficionado as a designation of engine size, and was, is and always will be, merely descriptive. The reason it was not required to be disclaimed (and wasn't) is that it is an integral part of the entire mark, not a mere "component" of the mark. Telescoped marks (such as 3.5RL) are considered unitary, so no disclaimer is required. TMEP § 1213.05(a)(i). Had the mark been 3.5 RL, there can be no doubt that "3.5" would have been required to be disclaimed. As a practical matter, it is the RL in 3.5RL that is source-identifying, as serves as a trademark.

Argument

Registration No. 2,281,336 recites a first use date of December 0, 1995; there would be no registration of 3.5RL if a specimen of such use had not been filed some time prior to the

registration date of September 28, 1999. Thus, RL has distinguished Honda automobiles from those made by others since at least 1999.

DaimlerChrysler's RL-CLASS claims a German priority date of February 28, 2003. Since the registration is presumed valid, and Lanham Act section 2(d), 15 U.S.C. § 1052(d) prohibits registration of marks confusingly similar to pre-existing registered marks, that means that the –CLASS component sufficiently distinguishes the mark to avoid likely confusion with Honda's previously-registered mark, the only source-indicating element of which is RL.

If Honda's earlier registration of RL can coexist on the register with RL-CLASS, then RL must necessarily be capable of coexisting on the principal register with RL-CLASS.

Conclusion

Applicant respectfully submits that the refusal to register must be reversed.